

REMARKS

Claims 1-28 are pending in this application. By this Amendment, Applicants amend claims 24-28 to place them in proper dependent form as suggested in the Office Action.

Applicants gratefully acknowledge the Office Action's indication that claims 1-23 are allowed. However, Applicants submit that all of claims 1-28 are allowable for at least the following reasons.

Initially, Applicants respectfully traverse the finality of the Office Action. Because the only rejection in the Office Action contains a new ground of rejection that was not necessitated by Applicants' amendment, the finality of the Office Action is improper.

MPEP § 706.07(a) recites in part that "...a second or subsequent action on the merits shall be made final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement..." (emphasis added). The present rejection of claim 24 under 35 U.S.C. § 112, second paragraph, was not asserted in any prior Office Action. Thus, the present rejection is a new ground of rejection. As recognized by the present Office Action, claim 24 was not amended in the Applicants' June 22, 2004 Amendment. Thus, the present rejection of claim 24 cannot be necessitated by Applicants' amendment of that claim. Finally, the rejection cannot be based on information submitted in an Information Disclosure Statement since the rejection is not based on prior art.

Because the rejection of claim 24 in the present Office Action is a new ground of rejection that was not necessitated by Applicants' amendment, Applicants' respectfully request that the finality of the Office Action be withdrawn and prosecution re-opened.

Furthermore, Applicants respectfully assert that even if the finality of the Office Action could be considered proper (which Applicants traverse), Applicants' amendments to claims 24-28 should still be entered in accordance with 37 C.F.R. § 1.116.

Particularly, entry of the amendments is proper under 37 CFR § 1.116(b) because, as discussed below, the amendments comply "with objections or requirements as to form" (see MPEP § 714.12). Additionally, entry of the amendments is proper under 37 CFR § 1.116 because the amendments (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration because the amendments merely rewrite the dependent claims into proper dependent form as suggested by the Office Action; (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to a new ground of rejection raised in the final rejection. Applicants thus respectfully request entry of the amendments.

The Office Action objects to claims 24-28 as being of improper dependent form. Applicants respectfully assert that amend claims 24-28 are in proper dependent form. Claims 24-28 properly include all of the features recited in the respective base claims and include additional features. For instance, according to claims 24-28, the position indication devices of the respective base claims must now be part of a game system including a information storage medium with a program that implements various sections (see MPEP §608.01(n)).

As a basis for the assertion that claims 24-28 are not in proper dependent form, the Office Action alleges that claims 24-28 are directed toward a separate invention (which Applicants traverse). However, MPEP §608.01(n) clearly states that "the fact that a dependent claim which is otherwise proper might relate to a separate invention...would not render it an improper dependent claim" (emphasis added).

Because claims 24-28 are in proper dependent form, Applicants respectfully request withdrawal of the objection.

The Office Action rejects claims 24-28 under 35 U.S.C. §112, first paragraph, as non-enabled. Applicants respectfully traverse the rejection.

The Office Action alleges that a computer-usable storage medium cannot comprise a position indication device. By virtue of the foregoing amendment to claims 24-28, the computer-usable storage medium no longer contains a position indication device. Accordingly, the Office Action's argument with respect to the position indication device is moot.

The Office Action further alleges that a computer-usable storage medium cannot comprise game processing means (now "section") or image generation means (now "section"). Applicants respectfully disagree.

First, claims 24-28 recite a game system that comprises a game processing section and an image generation section. Claims 24-28 further recite that the information storage medium comprises a program for implementing those sections on a computer. Thus, claims 24-28 do not recite that the information storage medium comprises the game processing section and the image generation section as asserted by the Office Action.

Moreover, applicants respectfully submit that it is well settled that a computer-usable storage medium may contain instructions which can be used by a computer to carry out various operations. Accordingly, a computer-usable storage medium is capable of containing instructions (e.g., a program) to implement various sections for processing a game (e.g., game processing section) and generating images (e.g., image generation section).

Therefore, Applicants respectfully assert that claims 24-28 are enabled by the specification as filed. Thus, Applicants respectfully request that the rejection be withdrawn.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-28.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite Examiner Brockett to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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